

REMARKS

Claims 4-9 are pending in the application.

Applicant has amended the specification and abstract to correct errors in translation and improve the English. Applicant has amended claims 4-6 and added claims 7-9. Claim 4 has been amended to particularly point out the subject matter of the invention; claim 5 has been amended to incorporate the limitations of claim 4 to which claim 5 used to depend; claim 6 has been amended to correct the error regarding the small chips. Support for the amendments to the specification and claim 1 are mostly self-explanatory; support for the amendments to the specification and claims 6 and 8 regarding the cross section of the small chips that form the centric chip can be found at Figures 1 and 2 in the specification as originally filed and in the PCT international application of which the subject application is the U.S. national stage; support for claims 7 and 9 can be found at Figure 2 in the specification as originally filed. No new matter has been introduced.

Applicant has noticed that the amendments to the specification on pages 2-3 in the Preliminary Amendment filed on July 24, 2006 have not been entered by the USPTO, even though amendments to the claims and abstract in the same document have been entered. Applicant again requests that the USPTO enter these amendments to the specification as shown in the preliminary amendment. A copy of the preliminary amendment as filed is enclosed.

Applicant requests favorable reconsideration of the subject application in view of the following remarks.

Specification

The specification was objected to for the informalities.

In response, Applicant has amended the specification to correct the informalities. The term "infarctuate" as spelt at paragraph 3, page 2, of the Examiner's office action is not used in the specification but "infarctate." Applicant has amended the term to a synonym, "solid," to clarify the meaning. Accordingly, the objection has been overcome.

Claim Rejections - U.S.C. 102

Claim 4 was rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 2,360,240 to Kjellstrom ('240 patent).

In response, Applicant submits that claim 4, as amended, is not anticipated by the '240 patent. To anticipate a claim, each and every element of the claim must be found in a single prior art reference. The '240 patent does not disclose, either expressly or inherently, the handle of the present invention having a round cross section that is a circle formed by bonding four circumjacent chips having curved cross sections.

Applicant appreciates that the Examiner's action point out the different meanings of the word "round," one of which being "free from angularity." Applicant has clarified in the amended claim 4 that "round" has its most ordinary meaning when used as an adjective here in the amended claim 4 of the subject application as being "shaped like a circle." The cross section of the handle of the subject application is as round as a circle as shown in Figures 1 and 2 and confirmed by the descriptions at page 3, paragraph 1, in the specification.

The element of round cross section as set forth in claim 4 is not disclosed by the '240

patent, either expressly or inherently. The title of the invention for the '240 is "Ski Stick." The '240 patent discloses ski sticks "made up of three or more longitudinal ribs glued together, which have been cut out of some initial material from a suitable vegetable source." Column 1, lines 10-13. The '240 patent discloses that the cross section is "inwardly curving" or formed by "concave external parts." Column 1, lines 53-55. Each and every claim of the '240 patent is directed to a "ski-stick" and contains the claimed limitation of "the external surfaces of said ribs being substantially concave in shape." Each and every figure of the '240 patent showing the embodiments of the invention contains the "concave" or "inwardly curving" outer border of the stick with irregularities. (Figure 14 shows the manner in which the ribs are "shaped out of the initial material," not the cross section of the ski stick. Column 3, lines 35-38.) None in the specification of the '240 patent discloses that the outer border of the cross section of the ski stick is round as claimed in claim 4.

In re Dailey does not apply here, because the case concerns the legal standard for determining obviousness under 35 U.S.C. §103, not anticipation under 35 U.S.C. §102(b). Were the Examiner to reject claim 4 as being obvious over the '240 patent, the claimed invention would still be patentable under the standard of In re Dailey. 357 F.2d 357. Because the claimed invention is not merely a matter of design choice which a person of ordinary skill in the art would have found an obvious modification over the '240 patent. As discussed, *supra*, the '240 patent is directed to a ski-stick, which, by definition, needs a firm grip at the handle. The characteristics of the concaved or inwardly curving border of the ski-stick as disclosed in the '240 patent coincide with its gripping function; the round configuration ensures slippery under the icy conditions and would not be used in the ski-stick of the '240 patent. One of ordinary skill

in the art would not modify the ski-stick of the '240 patent to arrive at the claimed invention.

Applicant believes that the amended claim 4 is not anticipated by (and would not be obvious over) the '240 patent. Accordingly, the rejection has been overcome.

Claim Rejections - U.S.C. 103

Claim 5 was rejected under 35 U.S.C. 103(a) as being obvious over the '240 patent in view of U.S. Patent 4,394,409 to Hertel ('409 patent).

In response, Applicant submits that claim 5, as amended, is patentable over the '240 patent in view of the '409 patent. As disclosed throughout the specification, the '409 patent discloses a composite wood article having a plurality of four elongated triangular-shaped pieces. Abstract. The chips bonded together in the '409 patent are triangular- or sector-shaped.

As discussed, *supra*, the '240 patent fails to disclose, either expressly or inherently, the cross section of the handle being round as a circle as set forth in the amended claim 5. The '409 patent fails to supply the missing teaching of the '240 patent regarding the round cross section. Further, the '409 patent fails to disclose the four chips of the present invention having a cross section of a curved border, a short straight border, and a long straight border.

Whether alone or in combination, the '240 patent and '409 patent fail to disclose the handle having four chips, each with a cross section of a curved border, a short straight border, and a long straight border and the cross section of the handle is round and forms a circle as set forth in the amended claim 5. The '240 patent directed to a ski-stick is teaching away from a round configuration, and any one of ordinary skill in the art, if only taught by the combined teachings of the '240 patent and the '409 patent, would not arrive at the claimed handle having a round cross section of a circle formed by four chips each having a curved border.

Accordingly, the amended claim 5 is not obvious over the cited prior art. The rejection has been overcome.

Claim Rejections - U.S.C. 103

Claim 6 was rejected under 35 U.S.C. 103(a) as being obvious over the '240 patent.

As discussed, *supra*, the '240 patent fails to disclose, either expressly or inherently, the cross section of the handle being round as a circle as set forth in the amended claim 6. It was not merely a design choice, and one of ordinary skill in the art would not arrive at the claimed invention by teaching (away) of the '240 patent. Moreover, since claim 4 is patentable over the '240 patent, claim 6 which depends on claim 4 is also patentable over the '240 patent.

Accordingly, the rejection has been overcome.

As the amended claims 4-6 are patentable over the cited prior art, claims 7-9 which depend on claim 4 or 5 are also patentable. Applicant believes that all objections and rejections have been overcome and claims 4-9 are now in condition for allowance, early notice of which is requested.

No fee is believed to be due. Should any fee be required, please charge same to Deposit Account No. 50-2586 and notify Applicant's attorney.

Respectfully submitted,
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